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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,957	10/11/2001	Masayuki Kushita	14987	7585

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GARDEN CITY, NY 11530

EXAMINER
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PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/974,957

Applicant(s)

KUSHITA, MASAYUKI

Examiner

Joseph T Phan

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☒ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 10/11/01 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because an English translation has not been provided and examiner is unable to locate the submitted documents in the English translation. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 11, and 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Line 2 of claims 1 and 5 and line 13 of claims 11 and 15 recites "...the other party..." It is unclear if "...the other party.." is referring to the originating caller or the called party. Appropriate clarification or correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**5. Claims 1-22 rejected under 35 U.S.C. 102(e) as being anticipated by Zahavi et al., Patent #6,577,859.**

Regarding claim 1, Zahavi teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up, comprising the steps of:

receiving a signal sent from a base station corresponding to a response of the other party to a call setup operation from a key-input section of a cellular phone (col.3 line 36-col.4 line 8);

reproducing audio data previously recorded and stored in a memory or synthetic audio data previously stored in a memory transmitting the reproduced audio data to the other party via a radio transmitter/receiver (col.5 lines 15-33)

and automatically terminating the call or disconnecting after the reproduction and transmission of the audio data are completed(*col.5 lines 43-51; the call is automatically terminated after transmission of the audio data*).

Regarding claim 2, Zahavi teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up as claimed in claim 1, wherein contents of the reproduced audio data are displayed on a display as text data during the transmission (Fig.2).

Regarding claim 3, Zahavi teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up as claimed in claim 1, wherein the reproduction of the audio data can be designated during the call including the point of time of reception (col.6 lines 1-39).

Regarding claim 4, Zahavi teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up as claimed in claim 2, wherein the reproduction of the audio data can be designated during the call including the point of time of reception(col.6 lines 1-39; point of time is asap).

Regarding claim 5, Zahavi teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up, comprising the steps of:

receiving a signal sent from a base station corresponding to a response of the other party to a call setup operation from a key-input section of a cellular phone reading out text data stored in a memory(col.6 lines 1-39)

converting the text data into audio data at a text-to-speech converter transmitting the converted audio data to the other party via a radio transmitter/receiver and automatically terminating the call or disconnecting after the transmission of the audio data is

completed (col.4 lines 43-51 and col.6 lines 1-39; *the call is automatically terminated after transmission of the audio data*).

Regarding claim 6, Zahavi teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up as claimed in claim 5, wherein contents of the text data are displayed on a display during the transmission (col.6 lines 1-39).

Regarding claim 7, Zahavi teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up as claimed in claim 5, wherein the readout of the text data can be designated during the call including the point of time of reception(col.6 lines 1-39).

Regarding claim 8, Zahavi teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up as claimed in claim 6, wherein the readout of the text data can be designated during the call including the point of time of reception(col.6 lines 1-39).

Regarding claim 9, Zahavi teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up as claimed in claim 7, further comprising the steps of indicating completion of the transmission on the display after the transmission of the converted audio data is finished reading out another item of text data stored in the memory and supplying the text data to the text-to-speech converter while retaining the call converting the text data into audio data at the text-to-speech converter and sending the converted audio data to the radio transmitter/receiver in succession(col. 5 line 15-col.6 line 39).

Regarding claim 10, Zahavi teaches an automatic sound transmitting method of a cellular phone in acknowledgment of a response of the other party when calling up as claimed in claim 8, further comprising the steps of:  
indicating completion of the transmission on the display after the transmission of the converted audio data is finished reading out another item of text data stored in the memory(col.6 lines 20-48) and supplying the text data to the text-to-speech converter while retaining the call converting the text data into audio data at the text-to-speech converter and sending the converted audio data to the radio transmitter/receiver in succession(col. 5 line 15-col.6 line 48).

Regarding claim 11, Zahavi teaches a cellular phone comprising:  
a key-input section for inputting a telephone number when making a phone call(col.5 lines 63-67), a text-entry and settings for respective functions a radio ransmitter/receiver for communicating with a base station by radio memories for storing previously recorded audio data and/or synthetic audio data and a controller(col.5 line 15 -col.6 line 39) which includes: a means for originating a call of a telephone number when the telephone number and a call up setup are inputted from the key-input section, a means for reading out the previously recorded audio data or the synthetic audio data stored in one of the memories on receipt of a signal sent from the base station corresponding to a response of the other party to the call, a means for sending the read audio data to the radio transmitter/receiver, and a means for terminating the call or disconnecting after the transmission of the read audio data is completed(col.5 line 15 -col.6 line 39; the call is automatically terminated after transmission of the audio data).

Regarding claim 12, Zahavi teaches a cellular phone as claimed in claim 11, further including a means for displaying contents of the reproduced audio data on a display as text data during the transmission(Fig. 2 and col.5 line 15 -col.6 line 39).

Regarding claim 13, Zahavi teaches a cellular phone as claimed in claim 11, further including a means for designating the reproduction of the audio data during the call including the point of time of reception(col.5 line 15 -col.6 line 39).

Regarding claim 14, Zahavi teaches a cellular phone as claimed in claim 12, further including a means for designating the reproduction of the audio data during the call including the point of time of reception(col.5 line 15 -col.6 line 39).

Regarding claim 15, Zahavi teaches a cellular phone comprising:  
a key-input section for inputting a telephone number when making a phone call(col.5 lines 63-67), a text-entry and settings for respective functions a radio transmitter/receiver for communicating with a base station by radio memories for storing inputted character data as text data a text-to-speech converter for converting the text data into audio data(col.5 line 15 -col.6 line 39); and  
a controller which includes: a means for originating a call of a telephone number when the telephone number and a call up setup are inputted from the key-input section, a means for reading out the text data stored in one of the memories on receipt of a signal sent from the base station corresponding to a response of the other party to the call and supplying the text data to the text-to-speech converter in order to convert the text data to audio data, a means for sending the converted audio data to the radio



transmitter/receiver, and a means for terminating the call or disconnecting after the transmission of the converted audio data is completed(col.5 line 15 -col.6 line 39).

Regarding claim 16, Zahavi teaches a cellular phone as claimed in claim 15, further including a means for displaying contents of the text data on a display during the transmission(col.5 line 15 -col.6 line 39).

Regarding claim 17, Zahavi teaches a cellular phone as claimed in claim 15, further including a means for designating the readout of the text data during the call including the point of time of reception(col.5 line 15 -col.6 line 39).

Regarding claim 18, Zahavi teaches a cellular phone as claimed in claim 16, further including a means for designating the readout of the text data during the call including the point of time of reception(col.5 line 15 -col.6 line 39).

Regarding claim 19, Zahavi teaches a cellular phone as claimed in claim 17, wherein:

either/both of the memories store plural items of text data and the controller further includes: a means for indicating completion of transmission on the display every time one of the plural items of text data has been converted into audio data and transmitted, a means for reading out another item of text data stored in one of the memories while retaining the call and supplying the text data to the text-to-speech converter in order to convert the text data to audio data, and a means for continuously sending the converted audio data to the radio transmitter/receiver(col.5 line 15 -col.6 line).

Regarding claim 20, Zahavi teaches a cellular phone as claimed in claim 18, wherein:

either/both of the memories store plural items of text data and the controller further includes: a means for indicating completion of transmission on the display every time one of the plural items of text data has been converted into audio data and transmitted(col.5 line 15 -col.6 line),

a means for reading out another item of text data stored in one of the memories while retaining the call and supplying the text data to the text-to-speech converter in order to convert the text data to audio data, and a means for continuously sending the converted audio data to the radio transmitter/receiver(Fig.2 and col.5 line 15 -col.6 line).

Regarding claim 21, Zahavi teaches a cellular phone as claimed in claim 19, further including a means for designating the number and order of the text data to be read out and transmitted to the radio transmitter/receiver in succession(col.5 line 15 - col.6 line).

Regarding claim 22, Zahavi teaches a cellular phone as claimed in claim 20, further including a means for designating the number and order of the text data to be read out and transmitted to the radio transmitter/receiver in succession(col.5 line 15- col.6 line).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 9:30-6:30, in every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

JTP  
December 11, 2003 *JTP*

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', with a long horizontal flourish extending to the right.